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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,799	08/06/1998	WOLFGANG FRAAS	P98.1428	4083

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EXAMINER

TSEGAYE, SABA

ART UNIT	PAPER NUMBER
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2662

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DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action

Application No.

09/117,799

Applicant(s)

FRAAS ET AL.

Examiner

Saba Tsegaye

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Continuation of 5:

Applicant's arguments (Remarks, pages 1-7) were carefully reviewed but they are not deemed to be persuasive.

In response to Applicant argument (Remarks, page 2) that the combination of Duault et al., Norizuki et al. and Yamada et al. does not teach or suggest the transmission system and ISDN subscriber terminal of the present invention, none of the pending claims (1-6) as they currently stand indicates an ISDN subscriber terminal.

Applicant argues (Remarks, page 3) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning. Examiner disagrees with Applicant contention. Both Duault and Norizuki teach conversion between TDM data and ATM cells. Further, Norizuki teaches that the ATM multiplexing transmission unit is coupled to other nodes via interface units 216, such as ISDN and dedicated digital lines (see Fig, 3B). Therefore it is clear that the obviousness analysis is based on the teaching of both Duault and Norizuki. The motivation is came from the teaching of Duault since Duault teaches the conversion between TDM and ATM. Further, Norizuki teaches TDM-base terminal equipment connected via a line termination as mentioned above, and this teaching is applied to the conversion between TDM and ATM cells of Duault. Thus, Examiner believes the conclusion of obviousness is not based upon improper hindsight reasoning.


In response to Applicant's argument (Remarks, page 4) that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ

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607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (SSPA 1971) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, Duault discloses TDM network connected via DTE (that is **exchange termination**) in both sides. As shown in Fig. 5, the Interworking function 15, converts TDM data into ATM cells, or ATM cells into TDM data. Norizuki teaches TDM based terminal equipment connected via a **line termination**. As shown in Figs. 2B and 3B, interfaces 213, 218, 220 establish an interface between a data, image and speech terminals and ATM multiplexing transmission unit. It would have been obvious to one ordinary skill in the art at the invention was made to substitute a line termination to the one of the DTE of Duault in order to distinguish the right side from the left side of the network and one would be able to describe the location of a fault or a malfunction of the subscriber or the transmission line and to be able to distinguish one DTE connection from the other DTE connection.

ST

June 4, 2004


JOHN PEZZLO
PRIMARY EXAMINER